



PATENT
Attorney Docket No.: 014861-600002

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:)
Allen et al.)
Serial No.: 10/629,447) Group Art Unit: 2856
Filed: July 28, 2003) Examiner: Rogers, David A.
For: INTERFACE BETWEEN A PIECE OF)
BAGGAGE AND A COLLECTOR)

CERTIFICATE OF MAILING

Mail Stop Non-Fee Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

I hereby certify that the following attached paper

- Second Preliminary Amendment (14 pages)
- Return Receipt Postcard

is being deposited with the United States Postal Service with sufficient postage as First Class Mail under 37 CFR 1.8 on March 24, 2004 and is addressed to the Mail Stop Non-Fee Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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SECOND PRELIMINARY AMENDMENT

Commissioner for Patents
P.O. Box 1450
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Sir:

Prior to examination on the merits, please delete claims 1-22 and add new claims 23-52 as set forth in Appendix A. Also, please amend pages 1, 9 and 13 of the specification as set forth in Appendix B attached hereto. The amendment to page 13 of the specification is a further description of Figure 6. That is, the amendment is supported by Figure 6, as well as various portions of the original specification. And, the drawings alone may support the claimed invention.¹ Accordingly, no new matter has been added by adding the paragraph in Appendix B.

During prosecution of the parent application—Application Serial No. 10/224,719—the Examiner cited *In re Dailey*, 357 F.2d 669, 149 U.S.P.Q. 47 (C.C.P.A. 1966) for the proposition that a change in shape is obvious. However, in that case, the Court of Customs and Patent

¹ See *Cooper Cameron Corp. v. Kvaerner Oilfield Products, Inc.*, 291 F.3d 1317, 1322-23, 62 U.S.P.Q.2d 1846 (Fed. Cir. 2002) (holding that Figure 7 provided an adequate written description); *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1565, 19 U.S.P.Q.2d 1111 (Fed. Cir. 1991) (“drawings alone may provide a ‘written description’ of an invention as required by § 112”).

Appeals held the claim-at-issue to be obvious because the Appellants had not presented an argument that convinced the court “that the particular configuration of their container [was] significant.”² In contrast, where the shape of an apparatus recited in the structure of a claim solves a problem or provides an advantage over the prior art, that shape is significant and cannot be held to be obvious.³

Here, new claim 23 is directed to an interface comprising a top securing member that has a particular shape. Specifically, the shape of the perimeter of the top securing member is non-circular shape and has at least one abutment. The abutment provides the advantage of allowing a slider portion of the zipper to zip up adjacent to and abut the interface. Thus, the shape of the perimeter of the top securing member in new claim 23 is significant. Accordingly, claim 23 is in condition for allowance, and Applicant respectfully requests examination and issuance of new claims 23-52.

Respectfully submitted,

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² *In re Dailey*, 149 U.S.P.Q. at 50.

³ See *In re Rinderer*, Appeal No. 2000-1651, 2002 WL 465339, at *2 (Bd. Pat. App. & Interf. 2002) (“In order to distinguish the claims over the prior art, an applicant is not required to recite the advantages flowing from the claimed invention; rather, the claims must include the structure which provides those advantages.”); *In re Moore*, Appeal No. 96--2852, 1996 WL 1796237, at *2 (Bd. Pat. App. & Interf. 1996) (“In contrast, the appellant’s specification . . . establishes that an arched neck as recited in claim 1 makes it easy to hold the chalk line against the surface to be marked without the need to reel out an excess amount of line or to wrap a portion of the line around user’s finger, thereby increasing the user’s control of the chalk box as compared to the traditional design. Thus, the shape of the neck recited in claim 1 is significant in that it solves a stated problem.”). For the convenience of the Examiner, copies of *In re Rinderer* and *In re Moore* are included with the Preliminary Amendment.